

non-elected claims or other appropriate action; and (3) each amended claim of the June 9 Response was not provided with the proper status identifier, and as such, the individual status of each claim cannot be identified. Each of the above-listed allegations are traversed.

I. Applicants' Election of Group II (claims 11-17 and 20-23) was Proper

In response to the request to restrict, Applicants are required to elect a group and identify the claims that are encompassed by the elected group, in accordance with 37 C.F.R. §1.143 and form paragraph 8.22 as recited in MPEP §818.03(b). Furthermore, Applicants may identify generic claims.

In the attached Amendment, claims 12-19 depend from claim 11, as such claim 11 must be generic to at least claims 12-19. The May 9, 2008 Restriction/Election of Species Requirement identified Group I as including only claims 11-15 and Group II as including only claims 16 and 17; however, because claims 11-15 are generic to at least Groups I and II, claim 11 is encompassed by at least Groups I and II. Therefore, in the June 9 Response Applicants elected Group II and properly identified the claims that were encompassed by the elected group.

Contrary to the assertions made in the August 6 PTO Communication, Applicants are not limited when making an election with traverse to include only the claims that the Examiner listed in the Restriction Requirement as belonging to the elected Group. However, "[a]ll claims that the examiner holds as not being directed to the elected subject matter are withdrawn from further consideration by the examiner in accordance with 37 CFR 1.142(b)."

Thus, after Applicants elect Group II and the claims Applicants believe read on elected Group II, the Examiner may withdraw the claims he believes do not read on the elected invention. In this case, because claims 11-15 are generic, Applicants respectfully submit that claims 11-15 read on at least Groups I and II.

II. MPEP Requirements for a Complete Response Were Fulfilled by Applicants

MPEP §818.03(b) requires that even when the request to restrict is traversed, an election must be made, wherein the election includes "identification of the claims encompassing the elected invention." Therefore, the MPEP does not require that in a Non-Final Action, a complete response must include cancellation or withdrawal of non-elected claims or other appropriate action under 37 C.F.R. §1.144, as asserted in that August 8 Communication.

In contrast, MPEP §821.01, titled After Election with Traverse, provides that after a **FINAL ACTION** the Examiner should indicate in the office action that a complete reply must include cancellation of the claims drawn to the non-elected invention, or other appropriate action in compliance with 37 C.F.R. §1.144.

Applicants respectfully draw the Examiner's attention to the fact that the May 9, 2008 Restriction Requirement is Non-Final, as indicated on the Office Action Summary. Therefore, the Examiner is prematurely requiring Applicants to submit a response to the May 9, 2008 Restriction/Election of Species Requirement that includes cancellation (or withdrawal) of non-elected claims or other appropriate action under 37 C.F.R. §1.144.

III. Examiner's Responsibility to Withdraw Claims

As provided in at least MPEP §821 "[a]ll claims that the examiner holds as not being directed to the elected subject matter are withdrawn from further consideration **by the examiner** in accordance with 37 CFR 1.142(b). See MPEP §821.01 through §821.04" (*emphasis added*). As such, in compliance with the procedures set forth in the MPEP, it is the Examiner that withdraws whichever claims the Examiner deems should be withdrawn.

Therefore, as indicated on page 5 of the June 9 Response, each claim was provided with the proper status identifier because Applicants could not indicate claims as being withdrawn before the Examiner had actually withdrawn any claims.

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For at least the reasons discussed above, Applicants believe the indication of non-compliance to be unreasonable.

However, to expedite prosecution, and in accordance with the Examiner's request during the August 13 telephone interview, Applicants submit a revised Amendment with Response to Restriction Requirement that indicates Group II includes only the claims the Examiner requested be indicated to read on the elected Group, and indicates that the non-elected claims are withdrawn.

Entry of the attached Amendment and Response to Restriction Requirement is requested.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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Attachment:

Amendment and Response to Restriction Requirement

Date: September 8, 2008

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